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| 10/815,889      | 03/31/2004  | Ori Gerstel          | 100101-000300US     | 9087             |

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Trellis Intellectual Property Law Group, PC  
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EXAMINER

ENG, DAVID Y

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| ART UNIT | PAPER NUMBER |
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2155

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10/02/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/815,889

Applicant(s)

GERSTEL, ORI

Examiner

DAVID Y. ENG

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 16-20 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15, 21, 22 and 24-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-27 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 3/31/04; 1/5/07.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### **Change of Inventorship**

In view of the papers filed 12/13/2004, it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 CFR 1.48(a). The inventorship of this application has been changed by adding Gary Baldwin to the record.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of Office records to reflect the inventorship as corrected.

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-15, 21, 22 and 24-27, drawn to a method for allocating a resource in a digital network, classified in class 709, subclass 226.
- II. Claims 16-19, 20 and 23, drawn to a method for creating a list of recommended routes to be used by a network control system, classified in class 709, subclass 238.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2)

that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination (claim 1, AB<sub>br</sub>) as claimed does not require the particulars of the subcombination (claim 16, B<sub>sp</sub>) as claimed for patentability. The subcombination (claim 16, B<sub>sp</sub>) has separate utility such as making a list for provisioning, failure recovery, analysis, optimization and other purposes (see [20] in spec.).

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

During a telephone conversation with Charles Kulas on 9/25/2007 a provisional election was made without traverse to prosecute the invention of I, claims 1-15, 21, 22 and 24-27. Affirmation of this election must be made by applicant in replying to this

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Office action. Claims 16-19, 20 and 23 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 22 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claim is directed to instructions (program) and therefore is non-statutory subject matter.

***Claim Rejections - 35 USC § 112 1<sup>st</sup> par.***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-15, 21, 22 and 24-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification fails to disclose a network planning tool for defining a recommended change in use of the resource as claimed. The planning tool is essential

to practice the claimed invention. Without the planning tool, one of ordinary skill in the art would not be able to make and use the invention without undue experiments.

***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> par.***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15, 21, 22 and 24-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to independent claims, it is not clear what "to define a recommended change in use of the resource" means. It is not seen how "change in use of resources" is related to resource allocation (the last step of claim 1, for example). Further respect to the second step (see claim 1 for example), it appears that step 2 has no use in the claimed method because resource allocation recited in the last step is according to the definition of step 1 and not step 2.

With respect to claim 2, it is not seen how a (recommended) route is related to use of the resource or change in use of the resource.

Further with respect to claims 21 and 22, "or" is vague and indefinite.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 21, 22, 24, 2, 25, 3, 26, 5-8, 13 and 9-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Sikora (USP 6,449,646).

Sikora teaches:

**Claims 1, 21, 22, 24,**

a method for allocating a resource in a digital network, the method comprising:  
using a network planning tool (inherent in a system having means for generating a resource list) prior to a time of operation (inherent, a resource list is inherently pre-generated so that the list can be used to allocate resources when resources are needed) of the digital network to define a recommended change in use of the resource;  
determining when a resource is needed (inherent, a resource list is pre-generated so that they can be allocated when they are needed) at the time of operation of the digital network; and  
allocating the resource at the time of operation of the digital network according to the definition of the recommended change in use of the resource (column 7, line 55-58).

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**Claims 2, 25,**

A route is inherent in a resource list so that the resource can be accessed for use.

**Claims 3, 26,**

A resource list is inherently has more than one resource and therefore more than one routes.

**Claims 5, 6, 7, 8, 13,**

The "wherein clauses" merely consist of non-functional descriptive material.

**Claims 9, 10, 11, 12**

The definition (resource list) is sent to which ever devices need the resource regardless what the names of the devices are.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 4, 27**

Claims 4 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sikora (USP 6,449,646) in view of Moure (USP 7,219,159).



Sikora teaches claim combination set forth above. Sikora does not prioritize the routes. Prioritizing routes is well known in the network communication art. See column 6 line 36-39. Moure teaches prioritizing routes in a route list. From the teaching of Moure, it would have been obvious to a person of ordinary skill in the art to prioritize the routes so that routes can be selected for use in accordance with priority.

**Claims 14, 15,**

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sikora (USP 6,449,646) in view of (Garfinkel USP 5,408,600)

Sikora teaches claim combination set forth above. Sikora does not update his list. Updating a resource list is well known in the network communication art. See the abstract line 17-18 in Garfinkel. From the teaching of Garfinkel, it would have been obvious to a person of ordinary skill in the art to update the list so that the list is more current and complete.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID Y. ENG whose telephone number is 571-272-3984. The examiner can normally be reached on M-F from 8AM to 3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, SALEH NAJJAR, can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'David Y. Eng', with a stylized, flowing script.

DAVID Y. ENG  
PRIMARY EXAMINER